



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1459
Alexandria, Virginia 22303-1459
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10 024,809	12 19 2001	Nancy L. Craig	35789 241825 (5789-3A)	3573

7590 05 20 2003
Gregory D. Williams
New England Biolabs, Inc.
32 Tozer Road
Beverly, MA 01915

EXAMINER
LAMBERTSON, DAVID A

ART UNIT PAPER NUMBER

1636

DATE MAILED: 05 20 2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/024,809

Applicant(s)

CRAIG, NANCY L

Examiner

David A. Lambertson

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION

- Extensions of time may be available under the provisions of 37 C.F.R. 1.136(a). However, any time so fixed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the period extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 135)
- Any reply received by the Office later than three months after the mailing date of this communication, even if time fixed, may reduce any earned patent term adjustment. (See 37 C.F.R. 1.134)

Status

- 1) ☐ Responsive to communication(s) filed on 19 December 2001
- 2a) ☐ This action is **FINAL** 2b) ☐ This action is non-final
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed
- 6) ☐ Claim(s) _____ is/are rejected
- 7) ☐ Claim(s) _____ is/are objected to
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner
- Applicant may not request that any objection to the drawing(s) be held in abeyance. (See 37 C.F.R. 1.85(a))
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner
- If approved, corrected drawings are required in reply to this Office action
- 12) ☐ The oath or declaration is objected to by the Examiner

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):
- a) ☐ All b) ☐ Some c) ☐ None of
- 1 ☐ Certified copies of the priority documents have been received
- 2 ☐ Certified copies of the priority documents have been received in Application No. _____
- 3 ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a))
- * See the attached detailed Office action for a list of the certified copies not received
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) to a provisional application:
- a) ☐ The translation of the foreign language provisional application has been received
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-945)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3, 7-9, 13-17 and 22-25, drawn to an isolated ATP-utilizing regulatory protein encoded by a transposon, and compositions comprising said protein, classified in class 530, subclass 300 and 350.
- II. Claims 4-6, 10-12 and 18-21, drawn to a transposon encoding an ATP-utilizing regulatory protein, and compositions comprising the transposon, classified in class 536, subclass 23.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions and are not disclosed as capable of being used together. In the instant case, invention I is a polypeptide whose function is the insertion of transposable elements, whereas the function of the transposable element of invention II is to encode a polypeptide. Furthermore, the transposable element (DNA) is structurally distinct from the polypeptide. Also, the protein of group I is not required for producing the transposon of Group II which can be produced synthetically (e.g., PCR amplification). Finally, the transposon of Group II is not required for producing the protein of Group I, which can be encoded by a cDNA. Because the inventions have different functions, they are considered patentably distinct.

Art Unit: 1636

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Additionally, these inventions require non-patent literature searches that are not co-extensive. Hence, searching both inventions would be burdensome. Therefore, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Lambertson whose telephone number is (703) 308-8365. The examiner can normally be reached on 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, Ph.D. can be reached on (703) 305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

David A. Lambertson
March 21, 2003

Donald B. Telford
PATENT EXAMINER
Gerald B. Telford
H. 4. 1636